

REMARKS

Claims 1-4, 6-11, 13, 14, 27, and 29-32 are pending in the present application after this amendment cancels claims 15 and 28 and adds new claims 30-32. The new claims do not add new matter, and find support throughout the specification and figures. In particular, the new claims are supported by original claim 9 of the present application. In view of the amendments and the following remarks, favorable reconsideration of this application is respectfully requested.

Claims 1-4, 6-11, 13, 14, 27, and 29 (claims 15 and 28 having been canceled) are rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 5,805,699 to Akiyama et al. (hereinafter Akiyama) in view of United States Patent Publication No. 2002/0176575 to Qawami et al. (hereinafter Qawami). Applicants respectfully traverse.

Claim 1 relates to a copy management system that includes, *inter alia*, a user terminal device, which comprises copy means for copying the content stored in the storage media to a first storage device, and which transmits device identification information attached to the user terminal device together with the unique media identification information of the storage media. In the copy management system of claim 1, ***the user terminal device deletes the copy enabling information after copying the content.***

The present invention has the advantage of being able to prevent unauthorized copying of content, since the user terminal device cannot copy the content again after copying the content by the above constitution.

The Examiner admits that Akiyama does not disclose deleting the copy enabling information after copying the content. (Office Action; page 3, lines 22-23). The Examiner asserts that Qawami discloses this feature in figure 9, step 225 and paragraph 58. However,

the Examiner asserts that the motivation to combine the references is to “limit the number of times the content can be used.” (Office Action; page 4, lines 12-13). However, this statement is not supported by either reference. In fact, this purported motivation appears to be merely a restatement of an advantage of the present invention.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either *explicitly or implicitly in the references themselves or in the knowledge generally available* to one of ordinary skill in the art. (MPEP 2143.01, emphasis added). “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

The Federal Circuit addressed the standard for obviousness and the requirement of motivation in Teleflex, Inc. et al. v. KSR Int’l Co., (119 Fed. Appx. 282; 2005 U.S. App. LEXIS 176). The patent at issue in *Teleflex*, related to an electronic pedal position control and a pedal assembly. In *Teleflex*, the district court granted a motion for summary judgment based on invalidity due to obviousness. The Federal Circuit vacated the decision and remanded to the lower court for further proceedings on the issue of obviousness. The Federal Circuit stated that, in regard to obviousness, “a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, *but some motivation to combine the prior art teachings in the particular manner claimed.*” (*Teleflex*, citing *In re Kotzab*; emphasis added). The Federal Circuit found that that there was no motivation to combine the Asano patent, which disclosed all of the limitations except

the electronic control, and the Rixon patent, which disclosed an electronic control and an adjustable pedal assembly. As the court further stated:

[t]he district court correctly noted that the nature of the problem to be solved may, under appropriate circumstances, provide a suggestion or motivation to combine prior art references. However, the *test requires that the nature of the problem to be solved be such that it would have led a person of ordinary skill in the art to combine the prior art teachings in the particular manner claimed.*

(*Teleflex*, citing as background *Rouffet*, 149 F.3d at 1357; emphasis added).

It is respectfully submitted that the present rejection is similar to the rejection discussed in *Teleflex* in that there is no motivation provided in Qawami to combine its teaching with the Akiyama. As the *Teleflex* court held, there must be *specific teaching* to motivate a person of ordinary skill in the art must to combine the prior art teachings *in the particular manner claimed*. Therefore, the combination of the references is improper and the result of hindsight reasoning, and the rejection of claim 1 should be withdrawn.

Independent claims 10, 27, and 29 are also rejected on the basis of the combination of the references. Therefore, for at least the same reasons as claim 1 is allowable, claims 10, 27, and 29 are also allowable.

The dependent claims are allowable for at least the same reasons as their respective base claims are allowable.

Additionally, claim 9 includes the feature of an intermediating server device which intermediates in the transmission/reception of information between the user terminal device and the server device, and which performs charge processing for the user at least when copy enabling information is transmitted to the user terminal device. The Examiner asserts that the feature of claim 9 is disclosed in Akiyama based solely on figure 8 including a “request

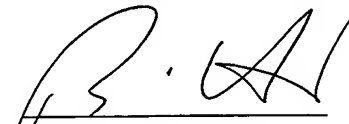
for billing”. (Office Action; page 7, line 19). There is no indication in Akiyama that the “request for billing” in figure 8 is performed by an intermediating server device, nor does Akiyama disclose a server intermediating between the transmission and reception of information that performs charge processing. It does not appear that any of the references disclose or suggest the features of claim 9, and therefore for at least this additional reason claim 9 is allowable.

New claims 30, 31, and 32 depend from claims 10, 27, and 29, respectively, and therefore each of these claims is allowable for at least the same reasons as their respective base claims are allowable. Additionally, claims 30-32 include features similar to those discussed above in regard to claim 9, and therefore each of these claims is allowable for at least the same reasons as claim 9 is allowable.

In view of the amendments and remarks set forth above, this application is in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,



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